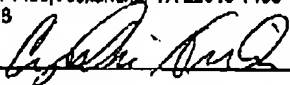| PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 113708.129	

I hereby certify that this correspondence is being facsimile transmitted to the USPTO (fax no. 571.273.8300) or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" (37 CFR 1.8(a)) on July 23, 2008	Application Number 10/692,793	Filed 10/27/2003
Signature _____	First Named Inventor LEE	
Typed or printed Name _Cynthia Nicholson_	Art Unit 2176	Examiner Quoc A. TRAN

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.

Signature

Cynthia K. Nicholson
Typed or printed name

☑ attorney or agent of record.
    Registration number __38,680__ .

(703) 707-9110
Telephone number

☐ attorney or agent under 37 CFR 1.34(a).

April 22, 2008
Date

    Registration number if acting under 37 CFR 1.34(a). _____.

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lee et al.	Atty. Dkt.: 113708.129
Serial No.: 10/692,793	Art Unit: 2176
Filed: 10/27/2003	Examiner: Quoc A. TRAN
Title: COMPUTER ASSISTED AND IMPLEMENTED PROCESS AND SYSTEM FOR ANNOTATING AND/OR LINKING ...	

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Window, Mail Stop AF   Date: 23 July 2008
Randolph Building
401 Dulany St.
Alexandria, VA 22314

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant respectfully requests a pre-appeal brief review of the examiner's rejections in

the final office action, mailed 28 December 2007 (hereafter "FOA"). A Notice of Appeal and

Pre-Appeal Brief Request for Review Form are filed with this Request.

ARGUMENTS

Claims 1-3, 6-10, 13-18 and 20-28 and 54 are pending. Claims 29-53 have been

withdrawn. The applicant respectfully submits that the rejection of the claims under 35 USC

103(a) in the Final Office Action is improper because it contains at least four clear factual or

legal errors, discussed below.

Claims 1-3, 6-10, 13-18, 20-28 and 54 were rejected under 35 USC 103(a) as being

unpatentable over U.S. Patent No. 6,877,137, Rivette et al. ("Rivette '137") in view of U.S.

Patent No. 6,687,878, Eintracht et al. ("Eintracht"). The final Office Action fails to make a

prima facie case of obviousness under 35 USC 103(a) because it does not consider limitations in

the independent claims. In overview, independent claims 1, 18, 25 and 21 recite elements that that are neither disclosed nor suggested in Rivette '137 or Eintracht, for example:

- "at least one merge component configured to retrieve the at least one document …, to retrieve the at least one annotation …, and *to combine the annotation data and the document data to form a unitary single logical document, the single logical document displaying the annotation embedded seamlessly in the document data.*" (Claim 1; see also independent claims 18, 25.)

- "at least one split component configured: *to extract the annotation data and the document data from the single logical document …, to update the at least one document … from the extracted document data…*" (Independent claim 18; see also dependent claim 7.)

Accordingly, the document (such as a patent) can be marked up with annotations, so that the document appears to have additional physical information seamlessly embedded therein and the marked-up document presents a unitary appearance. However, the annotations for different users are maintained separately so that unrelated users are protected from disclosing their marked-up documents to each other. (Specification page 32, lines 1-13).

The final office action admits that Rivette '137 does not teach the merge component or the split component, and cites Eintracht as teaching these elements. Eintracht's client displays document data (i.e., "image data") (FIG. 6, steps 118, 122), retrieves annotation data (i.e., "notes") from the server (step 124), stores notes received from the server within a local note database (step 134), and then displays the notes (step 136) in the form of a "stick note" that appears on top of the image (see also Col. 14, line 59 to Col. 15, line 14). Changes to the notes are buffered and returned to the server for synchronization.

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First, the final office action erroneously considers that Eintracht's layering of the notes over the image constitutes the merge component with the unitary single logical document displaying the annotation embedded *seamlessly* in the document data (FOA, page 10, lines 9-18). Eintracht FIG. 1B illustrates the annotations overlying the document (Col. 14, lines 17-19). A mark-up of Eintracht FIG. 1B is reproduced below, showing the single document window (14) in which annotations (16) are displayed over the image but are not part of the image itself:
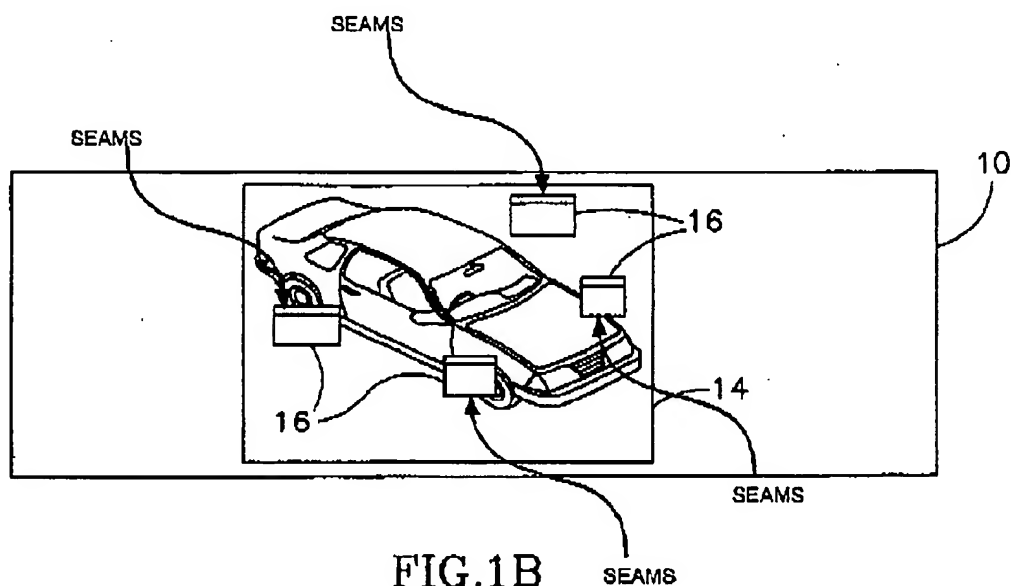

FIG.1B

As one can easily see, Eintracht's annotations (16) are not embedded "seamlessly" in the document (14). To the contrary, Eintracht refers to its annotations (16) as "stick" notes, and they have visible seams. An "annotation with seams layered on the document data" is clearly not embedded "seamlessly," no matter how the term "seamlessly" is interpreted. Consequently, Rivette '137 and Eintracht fail to teach or suggest combining the annotation data and document data to form a single logical document "displaying the annotation *embedded seamlessly in* the document data."

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Second, independent claim 18 additionally recites "at least one split component configured: to extract the annotation data and the document data from the single logical document." (See also dependent claim 7.) 37 CFR 1.104 requires that the particular part relied on must be designated and the pertinence must be clearly explained. The final office action argues that Eintracht teaches the split component (FOA page 12, line 11 to page 14, line 3 and page 31, line 15 to page 33, line 33), but never discusses where a reference teaches the limitation "to extract the annotation data and the document data from the single logical document" and appears to have completely skipped this limitation. For example, the final office action's quote from claim 18 is simply missing this limitation. The final office action's detailed discussion of claim 7 (FOA, page 16, line 12 to page 18, line 11) mentions the word "extract" but is similarly deficient, since it is copied from the rejection of independent claim 18. The omission of discussion of this element is not trivial since Eintracht's notes are not "extracted" from the single logical document; to the contrary, changes to notes are entered in the client's local notes database, buffered in the client's note buffer, and later posted as Annotation Events to the server to be merged into the server's Notes Database (Col. 15, lines 39-40; Col. 16, lines 2-19). Where is Eintracht's "extraction" of "annotation data and document data from the single logical document"?

Third, in comparison to claims 7 and 18, Eintracht does not update the *document data* (image) from the alleged unitary document — Eintracht discloses updating only the notes. The final office action completely skipped this element.

Fourth, in the rejection of claim 54, the final office action's reliance on incorporating the Microsoft Word for Windows Users Guide, 1994, "by reference in their entirety" (FOA, page 30, lines 1-3) is improper. The reference must be made of record and the rejection of claim 54 must

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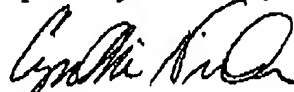Serial No. 10/692,793   Attorney Docket No. 113708.129

be withdrawn so that applicant can address the rejection. (See applicant's Amendment filed 31 October 2007, page 25, lines 1-11 for discussion, here applicable to claim 54.)

For at least these reasons, the final office action contains clear legal and factual errors and has failed to make a prima facie case of obviousness with respect to independent claims 1, 18 and 25 and dependent claim 7. The dependent claims are similarly patentable over the references.

In view of the foregoing, the applicant submits that there are clear errors in the rejection of claims 1-3, 6-10, 13-18 and 20-28 and 54. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,

Cynthia K. Nicholson
Reg. No. 36,880

Posz Law Group, PLC
12040 South Lakes Drive, Suite 101
Reston, VA 20191
Phone 703-707-9110
Fax 703-707-9112
Customer No. 23400

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